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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/828,543	04/20/2004	Jose Costa-Requena	NOKM.095PA	3880

7590 05/29/2008
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EXAMINER

AVELLINO, JOSEPH E

ART UNIT	PAPER NUMBER
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2146

MAIL DATE	DELIVERY MODE
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05/29/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/828,543	Applicant(s) COSTA-REQUENA ET AL.	
	Examiner Joseph E. Avellino	Art Unit 2146	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 April 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10, 12-29 and 31-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10, 12-29 and 31-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-10, 12-29, and 31-41 are pending. The Office acknowledges the cancellation of claims 11 and 30.

Claim Rejections - 35 USC § 101

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Claim 40 is rejected under 35 U.S.C. 101 because the claim is not statutory. The claim is a means-plus-function claim and as such can be implemented in software alone (specification, ¶ 87). As such, the “system” can be implemented as an interrelationship of software components, and is merely software, per se and fails to establish a statutory category of invention.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1, 40, and 41 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
5. Referring to claim 1, the claim recites “formatting the multimedia data via a network entity” which lacks antecedent basis.

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6. Referring to claim 40, the claim recites “the multimedia device” on line 3, which lacks antecedent basis.

7. Referring to claim 41, the claim recites “the multimedia device” on line 3, which lacks antecedent basis.

8. Correction is required.

Claim Rejections - 35 USC § 103

9. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-3, 7-10, 12-15, 19-23, 27-29, 31-34, and 38-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shinohara (US 2002/0132608) (cited by applicant in IDS) in view of Zehier et al. (US 2004/0136027).

1. Referring to claim 1, Shinohara discloses a method of exchanging multimedia data between a multimedia device (i.e. terminal 20) and a network (i.e. network 60), comprising:

digitally coupling a communication device (i.e. telephone 10) to the multimedia device (Figure 1; ¶ 35);

storing, on a data store (i.e. MMS user database server 30) accessible via the network (i.e. network 60) , a profile (i.e. data) of the communications device (i.e. mobile telephone 10₁₋₄), the profile adapted to include a description of multimedia capabilities of

the multimedia device (i.e. extension of the range of formats that each of the mobile telephones can receive...the current connection of external terminal 20₁ to mobile telephone 10₁ enables the reception of not only multimedia data of format 1, but of multimedia data, media data of format 2, that includes video data of format V2. The arrows in FIG. 4 indicate that the media type is the same as the media type of format 1) (Figure 4; ¶ 39-40);

accessing the profile for purposes of formatting the multimedia data via a network entity (i.e. results of the determination as to what the receiver formats can be received) (e.g. abstract);

formatting the multimedia data (i.e. multimedia message) via the network entity (i.e. transmitting entity) based on the profile so that the data is compatible with the multimedia device (i.e. based on the determination, alter the message to conform to the format the receiver can receive) (e.g. abstract); and

exchanging the multimedia data between the multimedia device and the network via the communications device (i.e. transmission and reception of data) (e.g. abstract; ¶ 54).

Sinohara does not specifically disclose the coupling is done via a UPnP network, and discovering the multimedia capabilities of the device via the UPnP network, rather that the telephone is “coupled” to the external terminal 20. In analogous art, Zehier discloses another multimedia service providing system which discloses, in a UPnP network, receiving, at a host 12, an advertisement, including multimedia capabilities, for a service 24 from a device 14, augmenting the host’s device capabilities description file

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30, and publishing the new service to a particular server to be used by particular clients (Figures 1-2, refs. 42-46; ¶¶ 24, 29, 35). It would have been obvious to one of ordinary skill in the art to couple the terminal of Shinohara with the communication device using a UPnP network as described in Zehier in order to provide an efficient method to connect various devices together in order to allow various to utilize services provided by particular devices using a well known protocol.

2. Referring to claim 2, Shinohara discloses the multimedia device comprises an audio playback device (i.e. format 2 is capable of playing the media type of “audio”) or a television (the Office construes any device which is capable of playing motion video a television, such as the terminal which is capable of playing a different version of video file) (Figure 4; ¶¶ 38-42).

3. Referring to claim 3, Shinohara discloses the invention substantively as described in the claims above. Shinohara does not explicitly disclose the specific format of a device profile. IN analogous art, Zehier discloses another multimedia coupling system which discloses the device profile is XML (i.e. a UPnP advertisement is inherently done using XML) (¶¶ 27-28). It would have been obvious to one of ordinary skill in the art to couple the terminal of Shinohara with the communication device using a UPnP network as described in Zehier in order to provide an efficient method to connect various devices together in order to allow various to utilize services provided by particular devices using a well known protocol.

4. Referring to claim 7, Shinohara discloses the network entity comprises a MMSC (i.e. multimedia message service) (Figure 1; ¶ 10).

5. Referring to claim 8, Shinohara discloses the invention substantively as described in claim 1. Shinohara does not explicitly disclose that when the terminal is uncoupled from the mobile telephone, the profile is updated to remove the description of the multimedia capabilities of the multimedia device. In analogous art, Zehier discloses another device service providing system which discloses that the profile is updated when a service is unavailable to indicate that the service is no longer available (i.e. removing a service) (¶ 34). It would have been obvious to one of ordinary skill in the art to couple the terminal of Shinohara with the communication device using a UPnP network as described in Zehier in order to provide an efficient method to connect various devices together in order to allow various to utilize services provided by particular devices using a well known protocol.

6.

7. Referring to claims 9 and 10, Shinohara discloses the communication device comprises a wireless mobile terminal (i.e. a mobile telephone 10) (Figure 1).

8. Referring to claim 12, Shinohara discloses the invention as described above. Shinohara does not explicitly disclose the communication device is configured to act as

an internet gateway for the UPnP network. In analogous art, Zehier discloses another internet multimedia device wherein the root device acts as a gateway for the UPnP network (i.e. device 14 does not connect to the network, rather goes through the host acting as a proxy) (Figure 1). It would have been obvious to one of ordinary skill in the art to couple the terminal of Shinohara with the communication device using a UPnP network as described in Zehier in order to provide an efficient method to connect various devices together in order to allow various to utilize services provided by particular devices using a well known protocol.

9. Referring to claim 13, Shinohara-Zehier discloses the invention as described in the claims above. Shinohara-Zehier does not explicitly disclose that the UPnP network is wireless, however a wireless UPnP network is well known in the art. By this rationale, "Official Notice" is taken that both the concepts and advantages of providing for a wireless UPnP network is well known and expected in the art. It would have been obvious to one of ordinary skill in the art to modify the system of Shinohara-Zehier to connect the device 14 to the host 12 via a wireless connection in order to promote roaming and the ability for the mobile user of Shinohara to freely move about without connecting to a network via a wired connection.

10. Claims 14, 15, 19-23, 27-29, 31-34, and 38-41 are rejected for similar reasons as stated above.

Claims 4-6, 16-18, 24-26, 35-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shinohara-Zehier as applied above in view of Coussement (US 2002/0114278).

11. Referring to claim 4, Shinohara-Zehier discloses the invention as described in claim 1. Shinohara-Zehier does not explicitly disclose the particular format of the device profile, but does disclose that it conforms to the UPnP specifications (Zehier: ¶ 24). In analogous art, Coussement discloses another terminal capability determination system which discloses the profile comprises a user/agent profile (¶ 21). It would have been obvious to one of ordinary skill in the art to substitute the profile format used in Shinohara with the profile format described in Coussement in order to provide the benefits commonly known to the use of XML, such as the ability to define values to be used in the profile, thereby tailoring the system to the user's liking.

12. Referring to claim 5, Shinohara-Zehier-Coussement discloses the use of a Profile-Diff header in a message sent to the data store in order to update the profile information (i.e. since Coussement discloses the use of CC/PP repository, it inherently discloses the use of a Profile-Diff header since this is defined as part of the CC/PP exchange protocol, see Ohto et al. "CC/PP exchange protocol based on HTTP Extension Framework" W3C Note 24 June 1999) (¶ 21).

13. Referring to claim 6, Shinohara-Zehier discloses the invention as described in claim 1. Shinohara-Zehier does not explicitly disclose the particular format of the device repository. In analogous art, Coussement discloses another terminal capability determination system which discloses the use of a CC/PP repository (§ 21). It would have been obvious to one of ordinary skill in the art to substitute the profile repository of Shinohara with the profile repository used in Coussement in order to provide the benefits commonly known to the use of CC/PP repository, such as providing a standardized mechanism and profile format for servers to be aware of device capability information.

14. Claims 16-18, 24-26, 35-37 are rejected for similar reasons as stated above.

Response to Arguments

15. Applicant's arguments filed April 17, 2008 have been fully considered but they are not persuasive.

16. Applicant argues, in substance, that claim 40 is statutory because the means is inappropriately read upon an interrelationship of software elements. The Examiner disagrees. The "means" can be considered only software or firmware, which is a specialized version of software, since the paragraph states that software may be used to perform the operations. There is explicit intrinsic evidence found in the specification which raises the issue that the "means" can read upon only software. As such, the

system can be only a plurality of software elements. Nothing within claim 40 as it stands requires the use of anything which would put this “system” as falling within one of the statutory categories of invention, rather a plurality of “means” which, as dictated by the specification, can be implemented as software alone. Software, per se, is not a process, machine, article of manufacture, or composition of matter, and, as such, fails to establish a statutory category of invention. Applicant is requested to amend the specification such that the "means" cannot be construed as only software or firmware. By this rationale, the rejection is maintained.

17. Applicant's other arguments are moot in view of the new rejections presented above.

Conclusion

18. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph E. Avellino whose telephone number is (571) 272-3905. The examiner can normally be reached on Monday-Friday 7:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey C. Pwu can be reached on (571)272-6798. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Joseph E. Avellino/
Primary Examiner, Art Unit 2146